

Remarks

This paper responds to the first Office action in the above-entitled application, mailed October 22, 2004, and allowing 30 days for a response. This response is timely because it is being filed within the period set for response.

Restriction Requirement

The restriction requirement is respectfully traversed because "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP § 803. One of the "two criteria for a proper requirement for restriction between patentably distinct inventions" is that "[t]here must be a serious burden on the examiner if restriction is not required . . ." MPEP § 803 (emphasis added). While "[f]or purposes of the initial requirement a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search . . . [t]hat prima facie showing may be rebutted by appropriate showings or evidence by the applicant." MPEP § 803 (emphasis added). The applicant rebuts the Examiner's prima facie showing in this case as follows.

The fields of search required to search the respective claimed processes and system are essentially coextensive. For example, any references relating to a process for coloring concrete will necessarily describe a system for coloring concrete, as the process must be carried out using some apparatus. Looking at the problem the other way, any references relating to apparatus for coloring concrete will necessarily describe a process for coloring concrete, as the apparatus will be described as useful to carry out a process. Moreover, both claims 1-24 and claim 25 recite or relate to: (a) providing a spray color dispersion comprising a pigment water dispersion and a polymer binding agent, (b) discharging a wet concrete mix from a vessel, and (c) spraying the spray color dispersion onto the concrete. Thus, their subject matter is closely related. A proper search of the method claims will require the Examiner to search for patents classified in the apparatus art, as well as the method art.

Moreover, the processes and apparatus have not been shown to have a separate status in the art. Separate classification of two references means that the first claims of the references are

separately classified. Two separately classified applications can and commonly do contain identical disclosures.

Finally, the elected group includes 24 of the 25 claims in the present application. The burden to search one additional, closely related claim is not substantial.

For these reasons, examining both process and composition claims in the same application does not present a serious burden in this instance. The restriction requirement should therefore be withdrawn.

Conclusion

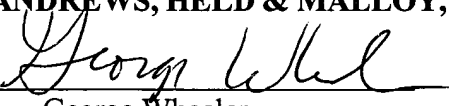
Therefore, the Examiner is respectfully requested to examine all of pending claims 1-25 in this application.

In addition, the Applicant notes that this application has been assigned in its entirety to Rockwood Pigments NA, Inc. ("Rockwood"). Rockwood filed an assignment recordal for this application on November 19, 2004. A power of attorney, along with a change of address, appointing the attorneys associated with Customer No. 23446, which includes George F. Wheeler, Esq., was submitted to the Office via facsimile on November 22, 2004. Rockwood revoked the prior power of attorney in the November 22, 2004, power of attorney.

Though no fee is believed to be due in connection with this response, the Commissioner is hereby authorized to charge any additional fees that are presently required, or credit any overpayment, to Deposit Account No. 13-0017.

Respectfully submitted,

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